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In re Application of :
Fainzibler, Kits, Burlingame, Olivera, Walker, :
Watkins, Shetty, Cruz, Imperial, and : **DECISION REFUSING STATUS**
Colledge : **UNDER 37 CFR 1.47(a)**
Application No. 09/210,952 :
Filed: 15 December, 1998 :
Attorney Docket No. 2314-147 :

This is in response to the petition filed under 37 CFR 1.47(a)¹ on 29 July, 1999.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 15 December, 1998, without an executed oath or declaration and naming Michael M. Fainzilber as an inventor.

Accordingly, on 29 January and 28 June, 1999, a "Notice To File Missing Parts Of Application" ("Notice To File Missing Parts") was mailed, requiring (a) the statutory basic filing fee; (b) additional claim fees; (c) an executed oath or declaration in

¹ A petition under 37 CFR 1.47(b) is inappropriate in this instance since one of the inventors has signed the declaration. A petition under 37 CFR 1.47(b) is only appropriate where none of the inventors will sign. Accordingly, the petition will be treated as a petition under 37 CFR 1.47(a).

compliance with 37 CFR 1.63, and (d) a surcharge for their late filing.

In response, on 29 July, 1999, a petition was filed under 37 CFR 1.47(a). Petitioner additionally submitted, *inter alia*, the following:

- (a) a declaration of Brent K. Brown;
- (b) a declaration of Joel B. Kirschbaum;
- (c) a copy of the University of Utah Policy and Procedures Manual, Subject; Patent and Inventions;
- (d) a declaration and power of attorney for the instant patent application naming Michael Fainzilber, Karel S. Kits, Alma L. Burlingame, Baldomero M. Olivera, Craig Walker, Maren Watkins, Reshma Shetty, Lourdes J. Cruz, Julita Imperial, and Clark Colledge as joint inventors, and signed by Maren Watkins on behalf of herself and by Brent K. Brown on behalf of the other joint inventors, and
- (e) the petition fee of \$130.00 and surcharge of \$130.00.

The petition states, *inter alia*, that the nonsigning inventors "have not explicitly refused to cooperate in the patent application process, but rather have simply not responded to requests to cooperate."

Petitioner should note that as a petition under 37 CFR 1.47(b) is inappropriate, petitioner is not required to establish a proprietary interest or irreparable damage.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee;
- (4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and
- (5) a statement of the last known address of the non-signing inventor.

The petition lacks items (1), (2), and (4). In regards to item (1), petitioner has not submitted sufficient evidence to prove that diligent efforts have been made to locate each of the non-signing inventors. Details of the efforts made to locate each non-signing inventor should be set forth in an affidavit or declaration of facts by a person having *first hand* knowledge of the details. The specific dates and times that correspondence was mailed, telephone calls or e-mail searches were made should be included. A copy of the application papers should be sent to the

last known address of each non-signing inventor with a request that he or she sign the declaration for the patent application. Petitioner should provide a copy of the envelope showing that the application was returned as undeliverable. Petitioner should also explain what attempts were made to obtain a forwarding address and to locate each inventor through other means. If attempts to obtain a forwarding address and to locate the inventor by other means (e.g. through e-mail or the telephone) continue to fail, then applicant will have established that the inventor cannot be reached.

Furthermore, the declaration of Brent K. Brown states that inventor Olivera was "out of town" and that inventors Kits, Shetty, Cruz, and College "are out of the country and unavailable." The fact that non-signing inventors are out of town or on vacation is not an appropriate reason for filing under 37 CFR 1.47.

In regards to item (2), petitioner has not submitted a proper oath or declaration in compliance with 37 CFR 1.63. The oath or declaration must contain the residence, post office address, and citizenship for each inventor. In situations where an inventor does not execute the oath or declaration and the inventor is not deceased, such as in an application filed under 37 CFR 1.47(a), the inventor's most recent home address must be given to enable the Office to communicate directly with the inventor as necessary.² Additionally, all of the signing inventors must sign the declaration on behalf of themselves and on behalf of the non-signing inventors. A declaration is acceptable if all of the signing inventors sign in their respective signature blocks and the signature block of the non-signing inventor is left blank or all of the signing inventors sign a statement saying that they are signing on behalf of the non-signing inventor.

In regards to item (4), the petition must list the last known address for each non-signing inventor.

²MPEP 605.03

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision should be directed to Petitions Attorney Douglas I. Wood at 703-308-6918.

A handwritten signature in cursive script, reading "Beverly M. Flanagan".

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy